

REMARKS

Claims 1-7 and 9-10 are pending in the present application. Reconsideration of the present application is respectfully requested in view of the proposed amendments and arguments set forth herein.

In the Office Action, claims 1-7 and 9-10 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Ishii (U.S. Patent No. 6,594,505) in view of Farazmandnia (U.S. Patent No. 6,625,472). Claim 8 has been canceled rendering the Examiner's rejection of this claim moot. Applicants respectfully traverse the Examiner's remaining rejections.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Furthermore, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Independent claims 1, 5, and 7 set forth, among other things, physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols. For example, an expansion card may be physically inserted into an

expansion slot of a personal data assistant. See Patent Application, page 6, ll. 20-25. In contrast, Ishii describes a mobile radio telephone 3 that may download communication protocol software from a base station 1 over a wireless communication link or air interface. See Ishii, col. 5, ll. 1-6 and Figure 1. However, the mobile radio telephone 3 is not physically attached to the base station 1. Thus, as admitted by the Examiner, Ishii fails to teach or suggest physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, as set forth in independent claims 1, 5, and 7.

Farazmandnia describes a Universal Serial Bus (USB) connection between a cellular telephone 3 and a personal computing device 1. The cellular telephone 3 may also communicate with a base station 5 over a wireless link 4. See Farazmandnia, col. 4, ll. 4-32 and Figures 1 and 2. The Examiner alleges that it would be obvious to one of ordinary skill in the art to modify Ishii so that the mobile radio telephone 3 may be physically connected to the base station 1, *e.g.*, using the USB connection described in Farazmandnia. Applicants respectfully disagree and submit that the prior art of record contains no suggestion or motivation for the Examiner's proposed modification and combination of the cited references. To the contrary, both of the cited references teach away from the Examiner's proposed modification and combination of the references.

Ishii teaches that mobile telephones located in a communication area associated with either a first or second base station may download first or second mobile radio telephone communication protocol software from the first or second base stations depending on which base station is serving the communication area. See Ishii, col. 4, ll. 27-51. When taken in context, Applicants submit that the description in Ishii is describing downloading the mobile radio telephone communication protocol software over an air interface. Consequently, Applicants

respectfully submit that Ishii teaches away from physically connecting a mobile telephone to a base station. Although Farazmandnia describes a USB connection that may be formed between a cellular telephone and a personal computer, Farazmandnia also teaches that the cellular telephone communicates with base stations over an air interface. Thus, Applicants respectfully submit that both Ishii and Farazmandnia teach away from the Examiner's proposed combination of the cited references. In particular, the cited references both teach away from using the USB connection described by Farazmandnia to couple a cellular telephone to a base station. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

Claims 2-4 depend from independent claim 1, claim 6 depends from independent claim 5 and claims 9-10 depend from independent claim 7.

For at least the aforementioned reasons, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 1, 5, and 7 are obvious over Ishii in view of Farazmandnia. Claims 2-4 depend from independent claim 1, claim 6 depends from independent claim 5, and claims 9-10 depend from independent claim 7. Thus, for at least the reasons discussed herein with regard to claims 1, 5, and 7, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 2-4, 6, and 9-10 are obvious over Ishii in view of Farazmandnia.

the present invention is obvious over the prior art of record. Applicants request that the Examiner's rejections of claims 1-7 and 9-10 under 35 U.S.C. § 103(a) be withdrawn.

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for allowance. The Examiner is invited to contact Mark W. Sincell at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON
CUSTOMER NO. 23720

/Mark W. Sincell/

Mark W. Sincell

Reg. No. 52,226

10333 Richmond, Suite 1100

Houston, Texas 77042

(713) 934-4052

(713) 934-7011 (facsimile)

AGENT FOR APPLICANTS

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